

**REMARKS****1. Provisional Election and Request for Modification**

Applicants, as required by the USPTO, provisionally elect Claims 1-9, 12-13, identified as "Invention I" by the examiner as drawn to a projection lithography system, classified in class 355, subclass 67.

Applicants request modification of Invention I to include also claims 10 and 11. These claims start with the words "A projection lithography system." Claims 1-9, 12-13 start with exactly the same words : "A projection lithography system." Obviously, these claims do not define separate inventions so independent and distinct as to mandate restriction. The examiner chose to classify claims 10 and 11 in a different subclass (355/75) rather than in subclass (355/67) with other claims to projection lithography systems. Even if the slight difference in classification should be appropriate, certainly there should be a cross-reference so as to make 355/67 overlap 355/75 in any well-planned search.

Applicants respectfully traverse this entire six-way restriction, on the ground that the claims do not define inventions that are so separate and distinct as to require division at all, and in any case, that the claims do not require such a drastic division as by the divisor "six."

Applicants and counsel recognize that the examiner has great flexibility in determining that there exists a single invention, or as many as six "separate and distinct" inventions, assuming he is presented with a situation where there are six unrelated, independent and distinct inventions. This patent application does not present such a group of six separate and distinct inventions. There is one single invention. Applicants have described that invention as a single invention in a single patent specification, and have defined that single invention by a reasonable number of claims (24) in that single patent specification. Applicants have already paid surcharges for four claims beyond twenty; applicants have already paid surcharges for four independent claims beyond the included three. Applicants request that the examiner exercise his discretionary authority to withdraw the restriction, or at least to modify the restriction in the interests of justice and administrative efficiency, because the six-way restriction is both unnecessary and oppressive.

**Justice.** This restriction, assuming that it might be maintained by the USPTO through the projected reconsiderations, protests and petitions, provides no justice to anyone. The only possible advantages to anyone are the proliferation of USPTO fees and the possible easy examinations of divisional patent applications. Greatly overbalancing this is the cost to applicants in paying such proliferation of fees, the waste of inventor time, patent counsel time and executive time – not to mention the waste of time and confusion to the public in attempting to make sense out of the multiple seemingly identical patents resulting if applicants should file the inferentially-suggested five divisional patent applications and prosecute them to grant. Even the possible multiple maintenance fees are unlikely to be profitable to the USPTO because the patent owner, also at great cost in inventor time, counsel time and executive time, must carefully review the decisions to pay all six maintenance fees. Applicants are punished with all this wasted time and excessive cost just to ease the examiner's requirement to search five heavily-cross-referenced subclasses. Even this quite tolerable search burden on the examiner rests on the examiner's own choice to do a paper document search rather than to do a simple key-word search by computer. Counsel is aware that the general burden on the examiner, to define and carry out

searches, is severe, but counsel urges that unnecessary restriction of patent applications is neither fair or effective as a technique to relieve such a search burden. Concentration on computerized searching promises a better solution.

Note that the examiner and patent counsel, communicating by recorded messages only, did not discuss the merits of the restriction. The examiner in his message (recorded in absence of patent counsel) repeated the restriction and, suggesting written response, mentioned the possibility of petition. Counsel considers it premature to petition at this time, since the examiner may still withdraw or modify the restriction, but reserves the right to petition at a later time.

**Oppressive.** If restriction acceded to by the applicant and followed by the five divisional applications inferred, the six resulting patents will be confusing to the public. Six patents from a single specification would appear to be identical, with no discernible difference in selection of invention. Such six patents will be very costly to the applicants with little or no advantage to the USPTO. Assuming that the restriction would be

continued by the USPTO through applicants' projected protests, requests and petitions, and assuming that the restriction is acceded to by the applicant and followed by the five divisional applications inferred, also assuming that all six applications are prosecuted through issue and that full-lifetime maintenance fees are paid. This would result in an estimated \$30,000.00 in additional USPTO fees, \$15,000.00 through patent grant and a similar \$15,000.00 in additional maintenance fees through patent lifetimes. Surprisingly, even at this proliferation of USPTO fees, there is little profit to the USPTO because much of the supposed extra \$30,000.00 in fees resulting from restriction followed by divisional applications is spent on administration, and there is a good chance that the complete set of maintenance fees will never be paid. USPTO spends essentially per-patent administrative fees for record-keeping, printing, classification and search file development. This spending continues as if the inventions were truly unrelated, and there may be even a tiny extra cost because of the confusion of handling such similar patents.

Counsel's experience has been that about a third of divisional applications are assigned to other examiners, who not only must study the invention and prior art, but are mystified by the reasoning that precipitated the restriction. One such mystified

examiner, in a previous multiple-way restriction in counsel's experience, even re-restricted one of the several divisional applications where the predecessor examiner had persisted over traverse and prevailed. The result in that application was that multiple divisional applications were filed. With that one divisional application, the new examiner restricted that divisional application, requiring still another traverse and supervisory review of still another restriction!

In practice, restriction appears to be most prevalent in chemical cases, where over-zealous practitioners use textbook or periodic table equivalencies to grind out multiple species beyond the six usually permitted by the examiner. Counsel, who no longer does chemical practice, does not feel qualified to comment on the merits of either the proliferation of chemical species or the acceptance of the six species. This patent application, however, is not a chemical application. It is an application for a patent for a projection lithography system.

**History.** It should be fully agreed that this restriction, and indeed the entire restriction practice, is about money. There is no clamor by the public over confusion

caused by multiple inventions in a single patent. The USPTO rightly insists that the applicant pay a fee for every patent. No two-fers!

The origination of the restriction requirement was simply a rule to protect the revenue of the Patent Office. Restriction was a Patent Office response to an outrageous fee-avoidance practice by a few unscrupulous patent practitioners. These unscrupulous practitioners attempted to cheat on the then-\$20.00 filing fee. For a single \$20.00 filing fee, they attempted to get a free search for one or even several extra inventions, by grouping two or more diverse inventions in a single patent application. The Patent Office rightly stopped this practice with the restriction requirement.

The pendulum has swung. The Patent Office now charges very substantial fees (\$1000.00-\$2000.00 for filing alone) plus additional fees during prosecution through issue, and three separate rising maintenance fees during post-issue years. The applicants in this case are now being subjected to outrageous fees, when a single, admittedly-unified patent application for what the inventors consider a single, unified invention, is subjected to a six-way restriction simply for convenience of the Examiner

and for multiple fees for the USPTO. In this case, the owner must choose between losing substantial patent rights (patent claims differing in scope or language) or paying six sets of fees. Note that applicant has already paid extra-claim charges. The reason given by the examiner appears to be simply the convenience of the examiner— so the examiner won't have to search two extra subclasses in one class and two subclasses in another class.

Note that there is no uniformity in USPTO restriction practice, with the minor exception of the six-species acceptance in chemical cases. In non-chemical groups, the usual response to restriction is to file a divisional application, in the expectation that the additional USPTO fees will be not much more than the cost of the legal fees to fight the restriction successfully by legal argument and possible petition. There is no protection to the public in this. Assuming six patents from a single specification and drawings, with claims differing only slightly, the public will be confused as to which patent claims what, and both judges and juries are sometimes impressed by the fact that the USPTO thought the inventions so major as to issue multiple patents.



Even the excess fees are unlikely to be profitable to the USPTO. Faced with a six-way restriction, a proper practitioner will petition, or at least protest, so examiner time and review time will be spent on justifying the oppressive restriction requirement, even if the applicant does not choose to file a formal petition for relief.

In this case, the examiner does not even allege that the inventions are really different – merely that the claims in his judgment should be placed in five different subclasses. Not even six subclasses for six suggested divisionals! This obviously means that the Patent Office, or at any rate the examiner, does not want to search beyond a single subclass for a single fee. This is contrary to long-standing practice of making a proper search at least within the group stacks. Modern computer searching makes it much easier to carry on a proper search extending beyond the group stacks, without concern for class and subclass.

Even granting the possibility that the examiner actually is convinced that the inventions are so different as to be a burden on the public; this is not stated and indeed this has never been stated by any examiner in the 47-year experience of counsel. The revenue of the Patent Office and the workload of the examiner – which

in this situation as in the usual situation are not even alleged – are quite obviously the reasons for this restriction, and indeed for virtually all restrictions. Let's get it out into the open--workload and fees drive the restriction practice. Using subclass as a criterion is a subterfuge. It is outrageous to pretend otherwise. Workload and fees! The USPTO recently changed its fee structure to charge a separate fee for the search. If a particular patent application should require so much searching as to be a burden to examiner and an excessive cost to the USPTO, why not face up to the situation and charge an extra search fee? Analogous to the fee for excess claims, why not charge a surcharge for the extra search beyond an included search of three subclasses? In this situation, two extra subclasses would earn two extra-search fees ( \$600.00) instead of five unnecessary divisional patents for \$30,000.00!

It is doubly outrageous to base restriction on subclass selection when "Inventions" I and VI both are classified by the examiner in the same subclass. (Here, Class 355, subclass 75.)

Applicants in restriction situations are in a Catch-22 dilemma, and practitioners are even more constrained. It is difficult to charge attorney time to arguing the

restriction and explaining why the applicants should bear the attorney time expense of arguing the restriction plus taking the risk of antagonizing the examiner. What is to be gained other than the hope of not having to pay the outrageous fees for the phantom "Inventions"? If the examiner is the absolute judge, and if the revenue of the Patent Office and the burden on the examiner are both at stake, why not just give up because the cards are stacked? What if the examiner really is correct, and there **really** are six inventions rather than one, and the patent attorney missed this without even getting a second opinion? Imagine the embarrassment.

Note that some companies grant awards to inventors solely on the basis of number of patents – inventors in such companies might be interested in getting six patents instead of one. Happy inventors might urge that it will weaken the eventual patent if we argue "one invention only" rather than simply accept the restriction and file five divisional applications?

What about the need for inventorship sorting if there are several divisional applications to be filed? Multiple inventors, who participated generally in the patent application, maybe did not participate as a group in the conceptions leading to one or more of the restriction sets of claims? Information for such inventorship sorting, much

less documentation of multiple conceptions, is very difficult to find at a time possibly years distant from the conception. Thinking there was one invention, the multiple conceptions may not have been documented except as a single joint invention. Must counsel use valuable time cross-examining his own inventors, and possibly setting these inventors one against the others, by seeking to eliminate one or more co-inventors from one or more sets of claims? Does the public gain from this costly and embarrassing effort?

Regardless of all the reasons to succumb to the restriction, counsel in this situation must request the examiner to reconsider this restriction. The restriction is unnecessary because the searches required are not outside the usual two classes and perhaps-four cross-indexed in-class subclasses. It is oppressive because it is so costly to applicants and confusing to the public. The restriction is further oppressive because there is no effective route of appeal. Even the petition is time-consuming and has burden of proof issues much like court appeals. Appeal would be best, because there is a chance to discuss the engineering verities with knowledgeable experts, but appeal is not available. Petition is not good because this is a procedural matter likely to be

accepted by the commissioner as properly based upon the examiner's opinion as an expert in the art.

Corporate practitioners generally don't even grumble about restrictions -- they just file easy divisional applications. Big law firms with wealthy clients typically don't fight such restrictions very hard, because their counsel fees may balance or outweigh the excess fees from the divisional applications. Considering the likelihood that the fight itself might well be both costly and unsuccessful, especially if the fight goes to petitions, the big patent law firms typically just suggest filing the divisional applications. At the very least, such unseemly scuffles over fees are so fraught with danger of non-success in arguments for reconsideration, and even non-success of petitions, and of the certainty of delays, that the big patent law firms simply seek client approval to file the divisional applications as a sort of business cost increase.

Perhaps current counsel, in-house as a one-person part-time legal department in a state-of-the-art high-tech small company, must carry the burden of argument against outrageous restrictions. Five divisional applications will cost an estimated \$50,000 over the lives of the five extra patents. Argument will cost at least \$2000.00 and it is a low-percentage bet that the six-way restriction will disappear entirely. If counsel fights and

loses, his choices boil down to losing patent rights or losing a major part of his year's budget. The examiner may be expected to fight just because his decision is being questioned, but the examiner doesn't want to use too much time in argument over procedure. The examiner may be motivated either to fight to the finish or, more likely, simply to repeat his restriction "for the reasons previously given." This moves the discussion inexorably toward petition.

Counsel's options become clear if the examiner does not at least respond to the details of the reasoning of the request for reconsideration. Counsel's experience has been heavily weighted toward the examiner's making the restriction FINAL, usually only with a cursory glance at the details of counsel's reasoning. In such a case, once the examiner makes the restriction FINAL, there is virtually no chance of compromise; counsel must choose between filing several divisional applications (incurring unbearable expense) or petition with its expense, delay and effort – plus finite chance of non-success. Counsel, having been sensitized by protracted and expensive efforts, sometimes futile, may determine that he should, in addition to starting discussions with the examiner and supervisor, and in supplement to any petition, seek legislative correction of this wasteful and unproductive Patent Office fee grab.

So let's compromise! Counsel suggests a two-way class-based restriction—(class 355 or class 430) if the Examiner will withdraw all subclass-based restrictions. This divides between “Projection Lithography System” and “Curved Mask for a Projection Lithography System.” These two classes are not independent and distinct, but they are at least separated at the class level. Counsel will elect the “Projection Lithography System” claims (Claims 1-13 and 19-24) so that prosecution may continue. Counsel will, however, reserve the option of petitioning to return the Class 430 claims (Claims 14-18) to the application.

As an alternative to petition, counsel will reserve the option to rewrite all of the Class 430 claims (Claims 14-18) to make each one dependent on a Class 355 claim (probably Claim 13).

**Remarks Responsive to Office Communication Comments**

1. **Six-way restriction.** Applicants contend that there is one invention described and claimed in this patent application, and have shown reasoned support for withdrawal of the restriction, or at least shown reasoned support for modification or compromise. Withdrawal of the restriction is requested.

2. **Subcombinations.** Applicants ask the examiner to reconsider the contention that examiner-identified "Inventions I-VI" are described as subcombinations disclosed as usable together in a single combination."

This statement is incorrect insofar as it might infer that there are six parallel inventions usable interchangeably. Claim 1 indeed defines a combination, not a subcombination usable with another subcombination in a combination. The combination is a projection lithography system, for curved surface lithography, having a number of required transmissive elements in a light path having illumination optics. These illumination optics are characterized by an illumination compensator having the zero-power aggregate optical effect. of two meniscus elements back-to-back.

[Combination]



Claim 2 (dependent on Claim 1) adds further characterization (clauses a –f) to the combination of elements of Claim 1. Some, but not all, of these added elements are known in prior art projection lithographic systems. [Combination with further definition of the elements and details of the combination.]

Claim 3 (dependent on Claims 1 & 2) adds further characterization (photo-opaque pattern on the exit surface of Zerogon means) to an element of the combination.

Claim 4 (dependent on Claim 1 & 2) adds further characterization (details of curved mask).

Claims 5-9 (dependent on Claim 1 & 2 & 4) add details to various elements, including the zerogon. Note that the zerogon is new in this patent application.

Additional claims (Claims 10-24) also provide elements and relationships of the invention. Claims 10, 11, 13, 14 , 17, 19, 20 and 24 , in addition to Claim 1, are independent claims for which six excess claim surcharges have already been paid.

Each claim deals with either a projection lithography system for a curved surface or a curved mask for such a projection lithography system for a curved surface. The curved mask is generally not referred to as a "combination," even though it may carry a complex pattern. While a curved mask may be one of a choice among several such curved masks, such curved masks eventually being potentially subject to individual packaging and sale, and eventually each bearing its own pattern, the presence of a mask in the projection lithography system is vital to the expected utility of both mask and system.

The mask is not separately usable simply because it may be separately packaged or even separately sold – it requires the entire lithography system for its use. The examiner's suggested "separate uses" are illusory. "Projecting images onto curved surfaces, using a curved mask" is a single utility, useful in a projection lithography system for patterning a curved substrate. Patterning of a curved substrate is the service, not an element in the claimed inventive combination. Since a proper curved mask is required in this invention, and was not appropriately available, applicants described how to make the curved mask. There was previously no "Zeroگون" available. Since the zeroگون is critical to the projection lithographic system described here, it is

an included element of this invention. The zerogon can serve as mask support and zero-power optical device, but its origin and its utility are in the projection lithographic system of this invention. There is currently no established supply of such devices, nor is there any established stand-alone or multi-system utility. Applicants may well become manufacturers of zerogon devices for general sale; demand for such devices in a multitude of varying systems coming to market would be welcomed. But, as of now, there is no such demand, no such separate utility. The only optimism for such widespread use is by the examiner, and this is based upon the examiner's own set of classification of the claims. The examiner's projected use of a zerogon, use as a zero-power device, would be welcomed but has yet to develop except for the invention here. Using a Zerogon to support a mask--except in the tight spaces of the projection lithographic system of this invention, appears to be contra-utility because of its expense as contrasted to a flat glass plate, unless all the other relationships of this projection lithographic system pertain. The examiner cites MPEP 806.05d, but is asked to withdraw this reference. This patent application is not a set of separate subcombinations usable together in a single combination, unless curved mask and zerogon are considered to be such.

The patent application must deal with focus problems as do most patents relating to high-resolution optics, but does not deal with “controlling of defocus” except as defocus is a possible problem to be avoided. Apparently the mention of “maintaining the image within the depth of focus” in the preamble of Claim 13, raised this specter. Claim 13, like most of the claims in this patent application, provides for a high-resolution projection lithography system which to be useful must avoid depth-of-focus overruns where possible. Such a massive and expensive projection lithographic system would not be economically useful as an off-the-shelf item for controlling of defocus in any known optical device.

Of course a curved mask, as broadly defined, could be obtained separately or at least built to order, and such a curved mask is known in prior art patents originating with some of the inventors who are applicants here.

**3. USPTO Subclass Alone Does Not Create “Separate Status.”** The examiner is asked to withdraw the comment in this numbered section. It is certainly not a pejorative comment directed to the excellent classification work done over the centuries

by the USPTO to state that separate classification (much less separate subclass selection by an examiner) does not in itself make each subclass definition justify a statement that the contents of the subclass or class “have acquired a separate status in the art...” Classification has many reasons for its existence—historically the reason is convenience of searching. Indeed, some subclasses owe their very existence simply to the fact that proliferation of patents caused overflowing the stacks in the previously designated subclass and it was easier to start a new subclass rather than to continue the expansion of a subclass so as to ripple a wave through a number of adjacent shelves.

**4. Does USPTO Subclass Alone Define Invention As Distinct?** Counsel cannot argue that examiner's statement in this paragraph is erroneous, except for the conclusion “Because these inventions are distinct for the reasons given above...” Restriction for examination purposes would indeed be proper if the inventions were indeed “Independent and distinct” per MPEP 802.011 and 35 USC 121. But the subclass itself does not make the invention independent and distinct. The subclass should follow, not lead, the realities of the science. The nuances of classification

should ease the pain of decision, not cause pain by requiring unrealistic choices of action by requiring painful dissection of inventions simply to fit classification pigeonholes.

Note that the examiner has discretion to ease this painful six-way restriction. Note also the MPEP definition of "INDEPENDENT" at the bottom of the first column on page 800-3, especially the second example "process and apparatus incapable of being used in practicing the process." Note also on page 800-3, second column, of MPEP, under heading "803 Restriction – When Proper," the following statement:

***"If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions."***

Certainly this statement provides an appropriate theme. It is important to note that the revenue of the USPTO and the reputation of the USPTO are at stake in the restriction theme. There is no doubt that the USPTO revenue was subject to sneak attack in the 1920's and early 1930's when the filing fee was just \$20.00 and the issue fee also just \$20.00. Even at such fee levels, unscrupulous practitioners tried to shun the fees by

grouping multiple unrelated inventions together into a single patent application. Times have changed, but possibly there still are a few unscrupulous patent p[ra]ctitioners who might try to squeeze multiple inventions together to save a filing fee. This, however, is not the situation of this patent application. Applicants and experienced counsel considered this a single invention. The reason for filing this patent application in its current form was not to save fees, but to present the invention properly. The examiner did not indicate any impropriety of unscrupulous merger of unrelated inventions to save on fees, but rather based his restriction simply on classification. Such a restriction based simply on classification must certainly find justification, if at all, on workload considerations – the examiner must consider the search required as being too difficult for a single patent application. Counsel urges that this is not the situation – that a reasonable search will be adequate to determine novelty for the invention disclosed and claimed in this patent application. Counsel has pointed out that the USPTO has already in this patent application charged fees for patent claims over 20 and for independent claims over 3.

There is no doubt that modern USPTO fees are substantial. Late in 2004 the USPTO added a separately-stated fee for the search in the application. Under appropriate circumstances, counsel (and, on information and belief, other modern

patent practitioners) would support a separate search fee for a search which reasonably required travel to a distant library or an Art Unit located in a separate community. Such an extra search fee would be but an inconsequential expense as contrasted to the cost of five divisional applications, which if filed in 2005 would each have an embedded search fee, as well as eventual related grant fees, and eventual related ever-rising maintenance fees. The examiner's efforts, to control USPTO expenses and to enhance the revenue of the USPTO, are over-zealous in this case. In this patent application, the search load is not excessive, but quite reasonable, even if both classes (355 and 430) and all five subclasses listed by examiner are to be searched. The examiner's efforts to cure search load problems through restrictions such as this are believed totally based on a mission to convert a real or imagined search load to a profit center by charging enormous USPTO divisional application fees for real or imagined greater search load. Counsel urges that this is *ultra vires*, beyond the scope of the examiner's authority. The examiner's authority does not extend to creating a new fee structure for the USPTO.

In this situation, the examiner has identified the following as a search load justifying the six-way restriction:



Class 355, subclasses 47, 67,75.

Class 430, subclasses 5 and 311

In the expectation of a petition for relief from this six-way restriction, counsel formally requests the examiner to state responses to the following:

1. An estimate of the expected hours required to search each of the three subclasses (47, 67 & 75) in Class 355; and the expected hours required to search each of the two subclasses (5 & 311) in Class 430.
2. An estimate of the degree of familiarity of the examiner with Class 355 and with Class 430, and whether the examiner considers himself "a person skilled in the art" with respect to each of Classes 355 and 430, or, if he prefers, the individual subclasses.
3. An estimate of the degree of cross-referencing in each of the three subclasses of Class 355 and in each the two subclasses of Class 430.
4. The examiner's experience in getting help with searching in an unfamiliar computer database or distant or unfamiliar stacks.
5. An estimate of the degree to which the examiner uses computer searching and the degree to which the examiner uses the stacks, and the difficulty of access by the examiner to the computer and to the group stacks.

6. An estimate of the amount of time the examiner has already spent on this restriction, plus the amount of time spent on the examiner's reply to this response to the restriction.

7. An estimate of the number of previous restrictions in which the examiner identified three or more "Inventions" other than species in chemical cases.

8. A statement whether the examiner has attended a USPTO class completely on the subject "restrictions," or whether the subject of restrictions was included along with other subjects in a single session.

9. An estimate of the number of applications in the experience of the examiner in which the respective patent counsels have accepted the restriction and filed one or more divisional patent applications without traverse; the number of times patent counsel has accepted in part and suggested compromise or lessening of the number of "inventions," and the number of times patent counsel has simply traversed his restriction

requirements as contrasted to the number of times patent counsel has traversed his restriction requirements accompanied by a request for reconsideration.

10. An estimate of the number of applications in which the examiner's restriction requirements have been made FINAL after change, and subsequently have been the subject of a petition for relief of the changed requirement.

11. An estimate of the number of applications in which the examiner's restriction requirements have been made FINAL without change, and have been the subject of a petition for relief of the unchanged requirement.

12. An estimate of the time required for the examiner to comment on, or to respond to, a petition for relief from the restriction requirement.

Counsel believes that these 12 questions can be answered by simple guesses written in the margin of a copy (supplied) of these 12 questions, or to be answered in a three-minute telephone call to counsel. The responses will be used in any petition, or communication to any member of Congress, but otherwise will be kept

anonymous, not published. Counsel has significant anecdotal experience with previous multiple restrictions and unnecessary two-part restrictions. Counsel of course must use introspection and consultation to determine whether counsel's techniques for claiming, or choice of technology, or habit of using an excessive number of claims, triggers such restrictions. Counsel, who has filed more appeals and petitions during the past five years than in the previous thirty years of practice, must also consider whether his age has made his efforts more subject to restriction.

**5. Election.** Counsel thanks the examiner for the reminder to communicate an election even if traversing. Applicants traverse and request reconsideration of the entire restriction. Applicants provisionally elect the "Invention I – Claims 1-9, 12-13, " and add a request to modify the restriction to include Claims 10-11 in "Invention I."

**6. Inventorship.** Counsel thanks the examiner for the reminder to review inventorship when claims are canceled. Applicants' provisional election has not yet resulted in any canceled claims or withdrawal of claims. Counsel's current belief is that the inventorship remains the same, but will review inventorship upon any change of

claims. This is a very time-consuming process, since modern patent practice does not require that each and every coinventor participate directly in the conception of the invention as defined in each and every claim, as was once the requirement.

**7. Communications** Counsel thanks the examiner for the communications information. Counsel has had telephone tag communications with the examiner, resulting in the examiner's recommendation to communicate in writing, which is now being done. Counsel also left a message for the examiner's supervisor, which message was returned, with a discussion of restriction practice generally and the impact of multiple restrictions on a small state-of-the-art company. Counsel also thanks the examiner for information on contacting the PAIR system. Counsel has yet to make use of the PAIR system, which does not appear to cover any needs of this patent application at present.

## **SUMMARY**

Counsel has made a sincere effort to understand both the theme and the detail of this restriction. Counsel has reviewed the MPEP, the statutes, and the rules, and has

also reviewed the history of the restriction requirement. Counsel is also reviewing the newly promulgated fee structure, in particular the separate fee for search. The examiner is asked to forgive the grumpiness of this communication, and if possible to ignore any personal considerations of complaint as to the examiner's interpretation of the restriction requirement. Such restrictions, which have recently proliferated, can overwhelm the intellectual property budgets of small, high-tech firms if the solution should be to file divisional applications. The solution of abandoning 5/6 of the claim groupings in the patent application is too dangerous; the small high-tech company cannot survive if its inventions, made at high cost and to be financed by one-of-a-kind or at best boutique production levels, are to be copied without redress. Even the costs of response to the additional Official communication, and likely petition, are daunting. The man-hours required of inventors, executives and patent counsel, even if the cost of such precious time expenditure should be ignored, are significant. Counsel in this response has made the necessary provisional election and has shown why the restriction should be withdrawn. Counsel has also requested that the examiner in his discretion withdraw the restriction. If the examiner does not withdraw the restriction in its entirety, he is asked at least to modify the restriction in the interests of justice and administrative efficiency. Should all counsel's entreaties fail, and the examiner persist

and make FINAL this restriction, counsel's current plan is to petition within the US Patent Office. Counsel also plans to publish in legal journals giving case studies and suggesting alternatives such as special intra-USPTO tribunals to give quick answers to restriction traverses, or possibly examination based solely on prior art supplied by applicant or counsel, or possibly examination based on counsel's representation of search criteria (two classes & up to six subclasses for a single search fee) or possibly even a no-search examination option. Possibly a special Search Facility, with professional computer searchers instead of the examiners, would be better. Obviously, counsel and others in his acquaintance would prefer search by the examiner, but current trends make it appear that examiners are losing determination or have diminished resources to carry out proper searches of complex inventions.

Six-way restriction is not the solution to the examiner search burden – such restrictions only add cost, delay and interminable discussion -- at the examiner, supervisor and petition levels. If the search burden on the examiner is too great, something should be done to relieve the increment to the examiner's search burden. Such increment to the examiner's search burden – perhaps 10% over the past decade if computerized searching is ignored – does not require a six-way division – a 600% increase in fees as a result of the usual solution of filing five divisional applications.



Charging 600% more to ease the examiner's 10% added burden is unrealistic and unfair.

Please withdraw the restriction and proceed with examination.

Respectfully,

Sivarama K. Kuchibhotla, Kanti Jain & Marc A. Klosner

By Carl C. Kling  
Carl C. Kling, Attorney  
(Reg. 19137)

## APPENDIX

(Copies of questions 1-12 on three sheets are supplied.)

## **Appendix 1 Questions Concerning Restrictions Generally**

1. An estimate of the expected hours required to search each of the three subclasses (47, 67 & 75) in Class 355; and the expected hours required to search each of the two subclasses (5 & 311) in Class 430.
2. An estimate of the degree of familiarity of the examiner with Class 355 and with Class 430, and whether the examiner considers himself “a person skilled in the art” with respect to each of Classes 355 and 430, or, if he prefers, the individual subclasses.
3. An estimate of the degree of cross-referencing in each of the three subclasses of Class 355 and in each the two subclasses of Class 430.
4. The examiner’s experience in getting help with searching in an unfamiliar computer database or distant or unfamiliar stacks.

5. An estimate of the degree to which the examiner uses computer searching and the degree to which the examiner uses the stacks, and the difficulty of access by the examiner to the computer and to the group stacks.

6. An estimate of the amount of time the examiner has already spent on this restriction, plus the amount of time spent on the examiner's reply to this response to the restriction.

7. An estimate of the number of previous restrictions in which the examiner identified three or more "Inventions" other than species in chemical cases.

8. A statement whether the examiner has attended a USPTO class completely on the subject "restrictions," or whether the subject of restrictions was included along with other subjects in a single session.

9. An estimate of the number of applications in the experience of the examiner in which the respective patent counsels have accepted the restriction and filed

one or more divisional patent applications without traverse; the number of times patent counsel has accepted in part and suggested compromise or lessening of the number of “inventions,” and the number of times patent counsel has traversed his restriction accompanied by a request for reconsideration.

10. An estimate of the number of applications in which the examiner's restriction has been made FINAL after change, and subsequently has been the subject of a petition for relief of the changed requirement.

11. An estimate of the number of applications in which the examiner's restriction has been made FINAL without change, and has been the subject of a petition for relief of the unchanged restriction.

12. An estimate of the typical time required for the examiner to respond to a petition for relief from the restriction.